

REMARKS

Applicants confirm the provisional election of Species III, i.e. claims 51-54, made orally during a telephone call on March 30, 2007.

Claims 29-54 are pending in the application.

Claims 51-54 are rejected.

Claims 29-50 are withdrawn.

Reconsideration and allowance of claims 51-54 is respectfully requested in view of the following:

Response to Restriction Requirement

The Examiner divides the claims into three species, with Species I including claims 39-44, Species II including claims 45-50, and Species III including claims 51-54. As per the phone conversation on March 30, 2007, Applicants elect without traverse Species III.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka (U.S. Patent No. 5,628,054) (Osaka hereinafter) and in view of Rasmussen et al (U.S. Publication No. 2003/0167244 A1) (Rasmussen hereinafter), as evidenced by Wehmeyer. This rejection is respectfully traversed.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach all the limitations of any rejected claim.

Rejection of Claims Based on Osaka, Rasmussen and Wehmeyer

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka and in view of Rasmussen, as evidenced by Wehmeyer. This rejection is respectfully traversed.

Claim 51 includes, in part, "wherein the battery subassemblies are designed to be shipped such that an additional shipping fee that would be incurred due to a chemical mass in the battery assembly is not incurred." Applicants agree with the Office Action that "Osaka does not disclose wherein battery subassemblies are designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred." Page 5, Lines 19-22.

Wehmeyer does nothing to overcome the deficiencies of Osaka. According to the Office Action, Wehmeyer "links the weight and watt-hour rating to one another through the disclosure of the energy density" and that "[w]hen the watt-hour rating adjusts, meaning it increases or decreases the energy density of the battery is able to provide, the weight of the battery also varies accordingly, because the watt-hour rating is shown in Wehmeyer as a function of weight." Page 6, Line 22 – Page 7, Line 6. What Wehmeyer actually teaches is that the energy density of each individual battery depends on the design of the individual battery, and that the energy density of the different types of batteries can change from one design to the next. According to Wehmeyer, an increase of specific energies and energy densities "can be attributed to a decrease in the weight and volume of the passive components of the cell." Page 201. As such, the watt-hour rating of a battery depends on the battery's design and cannot be determined based solely on the battery's weight.

As discussed above, Osaka and Wehmeyer fail to teach key limitations of independent claim 51. Rasmussen teaches nothing to overcome these deficiencies. Rasmussen teaches a system for optimizing weight based delivery fees for packaged advertising material. Paragraphs [0010] and [0011]. According to Rasmussen, "[t]his optimization is performed in light of the incremental nature of U.S. Postal and delivery service or private carrier delivery service weight breakpoints." Paragraph [0011]. If the teachings of Wehmeyer were combined with the teachings of Rasmussen, this would teach, at best, a system for optimizing weight based delivery fees for batteries based on the delivery service weight breakpoints based on the incremental characteristics of delivery rates. This does not teach battery subassemblies

designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable to claim 51, and those claims that depend therefrom.

No Teaching, Suggestion, or Motivation

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine Osaka with Rasmussen and Wehmeyer as required by the independent claims. Osaka does not teach battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a chemical mass in the battery

assembly is not incurred. Rasmussen also does not teach battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a chemical mass in the battery assembly is not incurred. Additionally, Wehmeyer also does not teach battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a chemical mass in the battery assembly is not incurred. If Osaka is combined with Rasmussen and Wehmeyer, as suggested by the Examiner, the result would not be as is required by the claims. The claims combine a battery assembly located in the battery bay and operable to provide power to the battery powered device, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically and electrically connected together to form the battery assembly, with battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred, which the suggested combination cannot achieve. In view of the above, a person of ordinary skill in the art would not have a reason to combine Osaka with Rasmussen and Wehmeyer. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims, and independent claim 51 is allowable at least for these reasons.

Thus, the reference does not provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for using the reference to support a 35 U.S.C. §103(a) rejection of the claims.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable to claim 51, and those claims that depend therefrom.

In view of all of the above, the allowance of claims 51-54 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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